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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,565	12/30/2004	Yasutaka Shimazaki	040-114	2825

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EXAMINER	
PRATT, HELEN F	

ART UNIT	PAPER NUMBER
1794	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/519,565	SHIMAZAKI ET AL.	
	Examiner	Art Unit	
	Helen F. Pratt	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

The amendment filed 12-30-04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: "Emulsifying after" as in paragraphs 0019, 0023 and anywhere else the phrase occurs. Also, no basis is seen in paragraph 0009 for the phrase "without producing okara".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No basis is seen in the specification for the phrase "emulsifying after" as in claims 1-4.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood what the phrase ""a basic food material producing step" means or includes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leneman, page 27.

Leneman discloses a process of making a tofu dressing (mayonnaise, page Xiii) by stirring medium or soft tofu with lemon juice or cider vinegar, oil, and blended to make a dressing in particular amounts (predetermined ratio). Claim 6 differs from the

reference in that it does not state how the tofu is made. However, tofu is known to be made by coagulating soybean milk and is an ancient food. Therefore, it would have been obvious to make a tofu mayonnaise as disclosed by Leneman.

Claims 7-8. are rejected under 35 U.S.C. 103(a) as being unpatentable over the above reference as applied to the above claims, and further in view of Hunter, page 41) and Ishizuka et al. (4,678, 676, claim 8 only).

Claim 7 further requires using a traditional method of making mayonnaise as in mixing acid with egg yolk and slowly adding in the oil and mixing to emulsify the mixture. Claim 7 differs from the traditional method in the steps of using a coagulated soy bean material and in adding it in the last step, and then adding a boiled acidulent. However, Leneman discloses adding tofu with other ingredients found in mayonnaise, and Hunter discloses that tofu can be added to one's favorite dressing (page 41, under "soy cheese dressing) in which the tofu is added after the dressing is made. No patentable distinction is seen at this time in adding the ingredients separately and in adding them together, absent a showing of unobvious results in the claimed method. No patentable distinction is seen in using a "boiled acidulent" since it is not clear whether the acid is hot when it is added or cool. If it were hot, it would be apt to cook the egg mixture. Also, Hunter discloses a method of making mayonnaise under "uncooked mayonnaise". Therefore, it would have been obvious to blend ingredients separately, instead of all together as shown by the references.

Claim 8 further requires using egg white instead of egg yolk and adding a saccharide at the end of the process. However, nothing new is seen in using egg white

since it is well known to substitute egg white if one is considering cholesterol problems. Also, Ishizuka et al. disclose that it is known to use egg white with oil and fat in an emulsified mixture (abstract and col. 6, lines 24-28). Also, nothing new is seen in adding a saccharide at the end, which is mainly a sweetener. Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Therefore, it would have been obvious to use known ingredients for their known function in the claimed process.

Claim 9, 10, 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leneman in view of Hunter as applied to the above claims, and further in view of Nakajima (7,029,719) and Asahi Chem (JP63304960) and Hadley's Natural Food CookBook, page 22.

Claim 9 further requires using as the soybean ingredient, ground up soybeans and water. However, ground up soybeans produces soy flour. No size of the soybeans is claimed to dispute this. Also, Ashai discloes that soybeans can be ground to a powder, dispersed in water, homogenized (emulsified) and then solidified using a solidifying agent (abstract). Hunter discloses maying tofu using soy flour, and water and a coagulant such as lemon juice (page 137). Hadley discloses that the difference between soy flour and soy powder is how fine the product is ground (page 22, 4th, para.) . It would have been within the skill of the ordinary worker to use which ever type of soy product would produce the best results especially as the reference discloses that the powder is good for use in liquids. It would have been obvious to substitute the soy powder for soy flour where required. Hunter discloses an eggless mayonnaise, which uses soy flour, water, oil (page 41, "Eggless Mayonnaise"). However, in recipes various ingredients can be used or left out. It is known to make mayonnaise with eggs, and without eggs as in Hunter. Nakajima et al. disclose that it is known to make a low fat mayonnaise using the emulsifying function of soy protein without egg yolk and it is known to use bean curd or soybean milk in making mayonnaise (col. 1, lines 55-58, col. 2, lines 9-15, col. 4, lines 20-34). Therefore, it would have been obvious to use egg as an emulsifier and ground soybeans (flour), or ground soy beans as disclosed by Asahi, since it is known to also use soy flour and oil in a mayonnaise mixture and egg and oil in a mayonnaise mixture.

Claim 10 requires grinding soybeans, drying removing the shell, adding water and then a coagulating agent to make tofu. Certainly this is how soy flour is made,

before, adding the water. As it is known to make tofu by coagulating soy milk (made from extracting ground soybeans in hot water) (col. 3, lines 10-15, lines 58-64), Nakajima), and then removing the solid parts, it would have been obvious to make a tofu using ground soybeans, since the coagulant acts on the protein in soymilk the same as it would act on the protein of ground soybeans.

The limitations of claims 1-5 have been disclosed above and are obvious for those reasons. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See In re Thorpe 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See Ex parte Jungfer 18 USPQ 2D 1796.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 10-24-07

HELEN PRATT
PRIMARY EXAMINER